

REMARKS

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the following remarks. Claims 1-23 were previously pending in the application. Claims 8 and 19 have been canceled without prejudice or disclaimer. Claims 1, 10-12, 16-17 and 22 have been amended herein. Applicant submits that support for these amendments may be found throughout the specification, for example on pages 11-12 of the specification. Applicant submits that no new matter has been added by way of this amendment.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 10, 11 and 12-16 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claims 10 and 11 herein to further clarify the relationship between the limitations in independent claim 1 and claims 10 and 11, which depend directly or indirectly from independent claim 1.

Regarding claims 12 and 16, the Examiner asserts, "Claims 12 and 16 recite the limitation 'receive a legal opinion document related to the trade'. It is unclear as to the relationship of this limitation to the step of receiving 'electronic authorization' and/or the 'transmit' step." (See, Office Action, page 2, ¶ 4).

Applicant submits that the claims are clear and definite. More specifically, Applicant submits that the claimed "executable software" (in independent claim 12) and the claimed "computer executable program" (in independent claim 16) are configured to cause the system or computer to execute several processes. Moreover, Applicant submits that the recited

limitations identified by the Examiner as allegedly indefinite, clearly set forth, *inter alia*, three processes that the system or computer are configured to execute. Accordingly, Applicant requests withdrawal of these grounds of rejections.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102/103

Claims 1-5, 9-18 and 22-23 have been rejected under 35 U.S.C. § 102(e), as being anticipated by Shields, et al., ("Shields") US Patent Publication No. 2002/0042771. Claims 6-8 and 19-21 have been rejected under 35 U.S.C. § 103(a) in view of Shields and in further view of existing business practices. Applicant respectfully submits that the claims are patentably distinct from the cited reference.

I. Amended independent claim 1 recites, *inter alia*:

A computer implemented method for processing restricted securities trades via a communications network, the method comprising:

receiving data relating to restrictions associated with the trade of a security...

automatically generating documentation supportive of the trade wherein the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied....

Applicant submits that the cited reference does not disclose, teach or suggest a system that generates documents including at least a legal opinion indicating whether the trade restrictions have been satisfied.

The Examiner acknowledges, "Shields fails to expressly teach the generated documentation comprises a legal opinion...." (See, Office Action, page 11, ¶ 4- page 12, ¶ 1). However, the Examiner asserts:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shields to generate any type of documentation supportive of the trade because the subjective nature of the document does not functionally relate to the steps in the method claimed and because the subjective interpretation does not patentably distinguish the claimed invention." (See, Office Action, page 12, ¶ 2).

Applicant respectfully disagrees with the Examiner's assertion that the generated documents are subjective and not related to the claimed method.

Amended independent claim 1 recites, "automatically generating documentation supportive of the trade wherein the generated documents include at least a legal opinion indicating whether or not the trade restrictions have been satisfied...." Accordingly, the generated legal opinion indicates whether restrictions associated with the trade of a security recited in the first limitation of independent claim 1 have been satisfied. As such, generating the legal opinion is not merely a subjective exercise, but instead part of the process of effectuating a trade. Therefore, Applicant submits that amended independent claim 1 is patentably distinct from Shields, alone or in combination with the "existing business practices" asserted by Examiner. Furthermore, Applicant traverses the Examiner's implied Official Notice that the generated documents are "existing business practices." Should the Examiner elect to maintain the rejections, Applicant requests that the Examiner produce a reference supporting his position.

II. Independent claim 12 recites, *inter alia*:

A computer system for facilitating trading of a restricted security, the system comprising:...

a computer server accessible with a network access device via a communications network; and

executable software stored on the server and executable on demand, the software operative with the server to cause the system to...

receive a legal opinion document related to the trade....

Applicant submits that Shields does not disclose, teach or suggest receiving a legal opinion document related to the trade.

Regarding the claimed legal opinion, the Examiner asserts that Shields' paragraph [0066] anticipates this limitation (See, Office Action, page 6, ¶3). More specifically, paragraph [0066] states, "In accordance with the invention, 'participant information' may pertain to client employer-related participant-specific information...[such as] proceeds, distribution instructions...and whether or not the participant is considered an insider pursuant to the New York Stock Exchange constitution...." (See, Shields, ¶ [0066]). Applicant submits that the cited passage is simply a list of database parameters that may be stored on Shields' Administration system 6.

In contrast to Shields' administrative database for storing participant characteristics, independent claim 12 recites "the software operative with the server to cause the system to...receive a legal opinion document related to the trade." Accordingly, Applicant submits that Shields' database parameters - one of which is related to a participant's status as an insider - does not anticipate configuring a system to "receive a legal opinion document related to the trade.", as claimed. Therefore, Applicant submits that independent claim 12 is not anticipated by Shields.

CONCLUSION

For at least the reasons discussed above, Applicant submits that amended independent claims 1 and 17 are patentably distinct from the cited reference. Further, Applicant submits that claims 2-7, 9-11, 18 and 20-21, which are directly or indirectly dependent from amended independent claims 1 and 17 respectively, are also patentably distinct from the cited reference for at least these reasons. Similarly, for at least the reasons discussed above, Applicant submits that independent claims 12, 16 and 22 are patentably distinct from the cited reference.

Moreover, Applicant submits that claims 13-15 and 23, which are directly or indirectly dependent from independent claims 12 and 22 respectively, are also patentably distinct from the cited reference for at least these reasons. Therefore, Applicant requests withdrawal of these grounds of rejections.


AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-005.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-005

Respectfully submitted,
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